

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-12 and 14 remain in the application and claim 1 is independent. The Office Action dated September 15, 2010 has been received and carefully reviewed. Each issue raised in the Office Action is addressed below. Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

Claim Rejections – 35 U.S.C. § 103

Claims 1-3, 6, 9, 10 and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wommelsdorf in view of Schmidt. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest each and every element in the claims. See MPEP § 706.02(j) and MPEP §§ 2141-2144.

Applicants respectfully submit that the combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Wommelsdorf and Schmidt.

Wommelsdorf shows a cup with a mouth roll and the rejection admits this reference fails to show or suggest a lid. Schmidt describes a cover or lid with a “curved edge 16”, but the curved edge projects radially inward from the container mantle, rather than outward, as is also admitted on page 3 of the Office Action. Having admitted that neither reference shows or suggests the curved edge to project radially inward, the rejection merely concludes that it “would have been obvious.” The rejection presents this unsupported conclusion without providing the complete fact finding, necessary under MPEP § 2141 and the following sections, to support such a modification. The rejection appears to have been based upon hindsight, guided by the instant disclosure, rather than establishing the necessary rationale. Therefore, it is respectfully submitted *prima facie* obviousness has not been established.

According to the Examiner, it would have been obvious to modify the mouth roll of the lid to extend radially outward “in order to obtain a conical shape.” This statement and conclusion are incorrect as the conical form does not depend upon the direction of the mouth

roll. Even more suspect and unreasonable is the Examiner's claim that the skilled person would have made the modification in order to allow nestable stacking of the lids. Nestable stacking of conical containers such as paper or board cups is conventional for reducing their volume for storing. But such saving in volume is normally not a concern with respect to lids, which usually are more or less flat in shape, and therefore do not create a storage issue when stacked. The rejection fails to present evidence that reversing a lid mouth roll direction to support nested stacking of lids would be desirable or important.

With respect to the Schmidt reference, the bottom (or cover) plate (3) of the lid is located about midway of the total height of the lid, substantially limiting any possible benefit of turning the mouth roll to make the lids stackable, and thus one of skill in this art would find the purported motivation illogical, thus undermining the basis for the proposed modification. As it stands, the lid of Schmidt does not appear to have been designed to be stackable, and any attempt by one of skill in this art to make it stackable would have been accomplished by slightly altering its dimensions, by slightly increasing the step inward (6 to 10, see Figures 5-8) or narrowing the mouth roll, rather than changing the direction of the mouth roll. Where is the evidence that reversing a lid mouth roll direction for stacking was known or desirable? Furthermore, due to the generally shallow configuration of the lid, the wall parts (4 in Figures 5 and 6 of Schmidt) would not come to a nested relationship necessary for achieving a stable stack, regardless of their being conically shaped or not. One of skill in the art would understand the wall or rim part would need to be lengthened to make a conical form useful for stacking, which would needlessly enlarge the lid. The Examiner presents no factual evidence that would rebut the more likely alternatives, and provide the necessary support for his obviousness argument.

The one time use cups of Wommelsdorf are designed to be dispensed one at a time from beverage machines. The rejection presents no reason as to why one of skill in this art would provide a cover of "high rigidity" from Schmidt for a cup from Wommelsdorf or how one would adapt the beverage dispensing machine to dispense such a lid and a cup, or provide a reasonable motivation for reversing the direction of the mouth roll. Thus, Wommelsdorf and Schmidt, either alone or in combination, fail to show or suggest the invention recited. It is respectfully submitted that what might superficially at first glance appear to be a logical modification does not stand up to the analysis that one of skill in the art would have made and does not establish *prima facie* obviousness. Applicants respectfully submit that the combination of elements as set

forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Wommelsdorf and Schmidt, for the reasons explained above. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

With respect to method claim 10, the Examiner asserts that making the cup and the lid by mutually corresponding operations would be obvious in light of the Wommelsdorf and Schmidt references. With all due respect, Applicants again disagree. Making the cup and lid in the same manner means that the cup and the lid will have the same basic structure, perhaps with differences in dimensions. In other words, the lid would be basically a cup with drastically reduced height so as to achieve a distance from the cup bottom representing the cup volume. The manner of making of the cup according to Wommelsdorf and the manner of making the lid of Schmidt are very different. These methods have nothing in common which would, after a factual analysis according to the *Graham* tests, have reasonably suggested the specific structure formed by the steps recited in claim 10 over and above the structure recited in claim 1. Reconsideration and withdrawal of these rejections are respectfully requested.

With regard to dependent claims 2, 3, 6, 9 and 14, Applicants submit that dependent claims 2, 3, 6, 9 and 14 depend, either directly or indirectly, from independent claim 1 which is allowable for the reasons set forth above, and therefore claims 2, 3, 6, 9 and 14 are allowable based at least on their dependence from claim 1. Reconsideration and allowance thereof are respectfully requested.

Claims 4, 5, 7, 8 and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wommelsdorf in view of Schmidt, and further in view of Wanderer, of record. This rejection is also respectfully traversed. Wanderer was cited to show stacking ring construction 26 and rim or lip portions 48 and 88 having protrusions 68, 70 and 72. However, Wanderer fails to show or suggest adjacent mouth rolls are provided at the mouth of the cup and the edge of the lid, the mouth rolls extending radially outwards and acting as grip bases when the lid is opened, and therefore cannot remedy the defects of Wommelsdorf and Schmidt as discussed in detail above. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Wommelsdorf in view of Schmidt, and further in view of Bacon. This rejection is also respectfully traversed. Bacon was cited to show techniques for bending the mouth of a container so as to form a mouth roll. However, Bacon only discloses manufacturing dies 50 and sleeves 62, 64 and 66 for forming rolled lips and fails to show or suggest adjacent mouth rolls are provided at the mouth of

the cup and the edge of the lid, the mouth rolls extending radially outwards and acting as grip bases when the lid is opened, and therefore cannot remedy the defects of Wommelsdorf and Schmidt as discussed in detail above. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

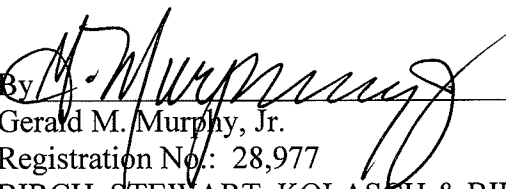
Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747
703-205-8000